STATEMENT REGARDING COMMON OWNERSHIP OF *ZIRKEL* PATENT

In accordance with the interview, the undersigned makes the following statement for the record for purposes of removing the *Zirkel* patent as a reference under 35 U.S.C. § 103(c):

U.S. Patent No. 6,135,349 to *Zirkel* is commonly owned with the present application by First Data Corporation, a Delaware corporation, as evidenced by the assignments of record in the present application and in the *Zirkel* patent. George S. Zirkel, the sole inventor in the *Zirkel* patent, is the same George S. Zirkel that is a named co-inventor in the present application. On information and belief, after inquiry of knowledgeable personnel at First Data Corporation, the subject matter of the *Zirkel* patent and the presently claimed invention were, at the time the invention was made, owned by the same person (First Data Corporation).

In accordance with 35 U.S.C. § 103(c), it is submitted that the *Zirkel* patent is not available as a reference under 35 U.S.C. § 102(e), (f), or (g).

REMARKS

Claims 1–15, 17–20, 22–24, and 26–52 are pending in this application, prior to this amendment. Claims 15, 20, and 24 have been canceled, in favor of new independent claims 53, 54, and 55, respectively, to present the subject matter of such claims in the format approved in *In re Beauregard*. Claims 47–52 have been canceled as directed to nonelected subject matter, without prejudice.

Reconsideration of the application and withdrawal of the rejections and objections is respectfully requested in view of these amendments and the remarks that follow.

Election/Restriction

Claims 47–52 (designated at Invention II) were indicated as directed to an invention considered independent or distinct from the invention originally claimed (identified as Invention I). The examiner stated that Invention I was related to Invention II as combination and subcombination, and asserted that inventions in this relationship were considered distinct, for the reasons indicated.

Application hereby confirms the election of the Invention I claims, and has canceled claims 47–52, without prejudice to the filing of one or more divisional applications directed to the nonelected subject matter of Invention II.

Claim Objections

Claims 15, 20, and 24 were objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. The examiner required that the claims be canceled, amended to place them in proper dependent form, or rewritten in independent form.

Applicants have elected to rewrite these claims in independent form, as claims 53, 54, and 55. No further response is believed necessary.

Claim Rejections - 35 USC § 103

Claims 1–15, 17–20, 22–24, and 26–46 are rejected under 35 U.S.C. § 103(a) as being unpatentable over allegedly admitted prior art, as described on pages 1-4 of the written

specification, in view of *Zirkel* (US 6,135,349), and further in view of *Kannady et al.* (US 5,263,164).

The *Zirkel* patent was cited as disclosing an allegedly similar method of activating a merchant account, and for the proposition that *Zirkel* includes activating the merchant account by means of the Internet, using appropriate computer hardware and software.

Applicants previously argued that the *Zirkel* patent was unavailable under 35 U.S.C. § 103(c) because both the instant application and the *Zirkel* patent were assigned to a "First Data Corporation," and, for applications filed on or after November 29, 1999, such as the instant application, references which qualify as prior art only under one or more of sections (e), (f), or (g) of section 102 are unavailable as prior art under section 103 if the claimed invention was, "at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." The examiner took the position that the *Zirkel* patent was indeed available as prior art under Section 103, because the burden of establishing that subject matter is disqualified as prior art under 35 U.S.C. § 103(c) falls on applicant, and applicant failed to establish such disqualification for reasons indicated in the office action, citing MPEP § 706.02(l)(1).

In accordance with the discussion during the interview, referenced above, the applicants, through the undersigned attorney, have made a statement in the record to the effect that the *Zirkel* patent was commonly owned with the subject matter of the present invention, at the time the invention was made. Accordingly, the *Zirkel* patent is not available as a reference. With the *Zirkel* patent not available as a reference, the citation to applicant's allegedly admitted prior art (any admissions of which are hereby traversed), either alone or in combination with the *Kannady* patent, is inadequate to provide any disclosure, teaching, or suggestion of applicant's claimed inventions. As has been pointed out in previous papers, the *Kannady* patent only teaches the notion of automating the collection of information from a customer and providing a "specification" of a transaction system to fulfill a customer's needs and desires. (Col. 2, lines 20–25). A specification is hardly a configuration for a point of sale terminal. The other comments from applicant's previous paper (mailed Sept. 10, 2004, pp. 26–29) are applicable, and incorporated by reference.

For the foregoing reasons, it there respectfully requested that the rejection of the

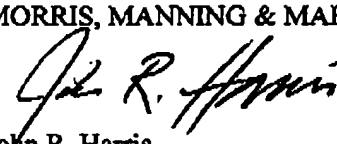
claims be withdrawn and that a Notice of Allowance be promptly issued.

The foregoing, in conjunction with the contemporaneously filed RCE, is submitted as a full and complete response to the Office Action final rejection mailed January 7, 2005 and is believed to have placed all claims in condition for allowance. Such action is courteously solicited. If any issues remain that can be resolved by telephone, the examiner is respectfully requested to contact the undersigned at 404 504 7720.

MORRIS, MANNING & MARTIN, LLP
1600 Atlanta Financial Center
3343 Peachtree Road, NE
Atlanta, GA 30326
(404) 233-7000
(404) 365-9572 - fax
jrh@mmmlaw.com

Respectfully submitted,

MORRIS, MANNING & MARTIN, LLP



John R. Harris
Reg. No. 30,388